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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,684	09/05/2003	Jeff Miller	HALB:045	8556
7590 Karen B. Tripp Attorney at Law PO Box 1301 Houston, TX 77251-1301			EXAMINER KUGEL, TIMOTHY J	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 10/31/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/656,684

## Applicant(s)

MILLER ET AL.

## Examiner

Timothy J. Kugel

## Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008 and 17 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 9-12, 16-20, 22, 25 and 29-35 is/are allowed.
- 6) ☒ Claim(s) 1, 6-8, 13-15, 21, 24, 26-28 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-22 and 24-39 are pending as amended on 12 September 2008, claim 23 being cancelled.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 September 2008 has been entered.
3. It is noted that claim 28 carries the status identifier 'Previously presented', yet there is an amendment shown in line 5 of the claim—"...a an emulsion..." This amendment appears to be an artifact from the amendment to the claims filed 21 April 2008. As a courtesy to applicant and in the interest of compact prosecution, claim 28 was construed to recite "...an emulsion..."
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment and Argument***

5. Applicant's arguments, filed 12 September 2008, have been fully considered but are not persuasive.

Applicant argues that the fluids of US Patent 6,006,831 (Schlemmer hereinafter) do not possess the properties claimed as shown by the affidavit of Ian Robb filed 12 September 2008; however, Robb is directed to the fluids of Schlemmer, while the closest prior art is that of US Patent 4,777,200 (Dymond hereinafter), which differs from the instant claims only in that the instant claims require a synthetic oil continuous phase.

Further, should Schlemmer have been the closest prior art, the results reported by Robb show a gel progression index of 0.08 to 0.20 between the two formulations—which differ in the amount of total emulsifier, lignite and clay present—shown. It is the examiner's position that the teaching of Schlemmer of a gel progression index of 0.2 reads on the instant claims of "about 0.3" since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering optimum or workable ranges involves only ordinary skill in the art. See MPEP 2144.05(II) and *In re Aller*, 220 F2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

***Claim Rejections - 35 USC § 103***

6. Claims 1, 6-8, 13-15, 21, 24 and 26-28 stand and new claims 36-39 are rejected under 35 USC § 103(a) as being unpatentable over US Patent 4,777,200 (Dymond hereinafter) in view of US Patent 6,006,831 (Schlemmer hereinafter).

Dymond teaches an invert emulsion (Abstract) drilling fluid (Column 1 Lines 8-14) within the scope of the present invention, which comprises copolymers having 25 to 100% of a polar hydrophobic monomer (Abstract and Column 6 Lines 40-63) such as the claimed 2-ethylhexyl acrylate (Column 7 Lines 19-23) and 0 to 20 % of a hydrophilic monomer (Column 7 Lines 19-23) such as acrylic acid (Column 7 Lines 56-64) and that the copolymer may be in the form of particles coated with a hydrophilic coating (Column 7 Lines 23-33).

Dymond, while teaching mineral oil, does not disclose expressly the use of a synthetic oil.

Schlemmer discloses a wellbore treatment fluid comprising any of aliphatic or aromatic mineral oils or synthetic hydrocarbons such as paraffins or olefins (Schlemmer Column 8 Lines 55-67).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the mineral oil taught by Dymond with the synthetic paraffins or olefins of Schlemmer. The rationale to do so would have been the motivation provided by the teaching of Schlemmer that the mineral oils of Dymond are functional equivalents to the synthetic paraffins and olefins taught by Schlemmer (Schlemmer Column 8 Lines 55-67).

Since Dymond and Schlemmer combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the progressive gel and stress build behavior, suspension, fluid loss control, filtration control, thickening, yield and sag behavior and viscosity of the

Dymond/Schlemmer composition would intrinsically be the same as claimed. If there is any difference between the product of Dymond and Schlemmer and the product of the instant claims the difference would have been minor and obvious.

***Allowable Subject Matter***

7. Claims 2-5, 9-12, 16-20, 22, 25 and 29-35 are allowed for the reasons of record.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached on 5:30 AM - 4:00 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/  
Patent Examiner, AU 1796